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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/293,163 04/16/99 KERR

E 5593

EXAMINER

IM62/0410

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REDDICK, M

ART UNIT

PAPER NUMBER

1713

DATE MAILED:

04/10/01

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/293,163

Applicant(s)

KERR ET AL.

Examiner

Judy M. Reddick

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. ***The following is a quotation of the second paragraph of 35 U.S.C. 112:***

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. ***Claims 1, 2 and 4-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.***

A) ***The recited "average molecular weight" per claim 1 constitutes indefinite subject matter as per it not being readily ascertainable as to the exact type intended, i.e., "weight average" or "number average", the two being substantially different.***

Claim Rejections - 35 USC § 102

3. ***The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.***
4. ***Claims 1, 2 and 4 -7 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Halverson and(or) Richardson et al as per reasons of record per paper no. 5, 09/13/00, paragraph no. 6. Further, the polymers, in terms of the molecular weight, although in different terms, may very well be met by both Halverson and Richardson, in the absence of the USPTO to have, at its disposal, the tools and/or facilities deemed necessary to***

make physical determinations of this sort. There is absolutely nothing viable on this record diffusing this issue.

Claims 1 and 5 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Horsley et al as per reasons of record per paper no. 5, 09/13/00, paragraph no. 7.

Further, the polymer of Horsley et al may very well overlap in scope with the claimed polymer, in terms of molecular weight, in the absence of the USPTO to have at its disposal the tools and/or facilities deemed necessary to make physical determinations of this sort. In any event, even if this turns out not to be the case, the generic polymer necessarily implies that any polymer including the claimed polymer would have been operable within the scope of patentees disclosure and with a reasonable expectation of success. Moreover, the use of any commercially available sulphonated polymer in lieu of the disclosed sulphonated polymer of Horsley would have been obvious to the skilled artisan and with a reasonable expectation of success. Criticality for such, commensurate in scope with the claims, not having been demonstrated on this record.

Claim Rejections - 35 USC § 103

6. *The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.*

7. *Claims 2, 4, 6 and 7 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Horsley et al in combination with Brown et al as per reasons of record per paper no. 5, 09/13/00, paragraph no. 9.*

Response to Arguments

8. Applicant's arguments filed 01/23/01 have been fully considered but they are not persuasive.

Relative to Halverson or Richardson, Horsley et al and Horsely in combination with Brown—The crux of Counsel's arguments appear to hinge on neither of the references alone or in combination teach the use of a sulfonate-containing polymer having the molecular weight, as claimed, for rheology modification of mineral-containing solids.

With all due respect to Counsel's opinion, as discussed supra, the polymers of the prior art may very well possess the claimed molecular weight, just defined in alternative terms. There is absolutely nothing viable on this record to rebut this issue. Mere attorneys arguments unsupported by factual evidence are given little weight. Reference In re Lindner(173 USPQ 356). Even if this turns out not to be the case, the use of any commercially available sulfonate/sulphonate-containing polymer in lieu of the sulfonate/sulphonate-containing polymers of the prior art supra would have been obvious to the skilled artisan and with a reasonable expectation of success. Criticality for such not having been demonstrated on this record.

With respect to "dispersant"(Inventive) VS flocculant (prior art)—The discovery of a new property or use for a previously known compound cannot impart patentability to claims to that compound, even if the property or use is unobvious from the prior art. Reference In re Schoenwald(22 USPQ 1671).

Prior Art f Record

9. **Note the attached PTOL FORM-892 for additi nal pri r art cited as of interest and considered merely cumulative to the prior art supra.**

Conclusion

10. **THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).**

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. **Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m.**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or

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proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

J. M. Reddick
Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR *JMR*
April 5, 2001